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ROBERT P. RAYMOND  
BOEHRINGER INGELHEIM CORPORATION  
900 RIDGEBURY ROAD,  
P O BOX 368  
RIDGEFIELD CT 06877

EXAMINER

ROTMAN, A

ART UNIT

PAPER NUMBER

1612

DATE MAILED:

01/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/025,690

Applicant(s)  
Norbert Huel et al.

Examiner  
Alan L. Rotman

Group Art Unit  
1612



☒ Responsive to communication(s) filed on Applicants' Response filed January 4, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) 7 and 15-17 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-6 and 8-14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

applicants' attorney has provisionally elected the compound species of Example 113 on Page 116 of the instant specification, which corresponds to the compound species of claim 10 and closely related to the compounds (e), (f), (g), (h), (l), (m) of claim 6 and claims 8 and 9 respectively. The provisionally elected species of the above cited compounds have been examined and found allowable. The restriction requirement of record is hereby modified in the following manner:

**Group V1: The above identified compounds (e), (f), (g), (h), (l), (m) of claim 6, the compound species of claims 8 through 10 and a physiologically acceptable salt according to claim 11, but limited to the scope of the provisionally elected compound(s), pharmaceutical composition according to claim 12, but limited to the provisionally elected compound(s) and finally method of using according to claims 13 and 14, but limited to the provisionally elected compounds indicated above. There was no apparent traverse in applicants' election Response received in the PTO on January 04, 1999, (Paper No. 4) respectively.**

**Claims 1-6 and 10-14 in-part are rejected under Judicially created doctrine as being drawn to an improper Markush group on the grounds of lack of a common nucleus. It is indisputable that the terms (Ar) and (Het) in the depicted formula in claim one represent a plethora of independent and distinct ring systems, which are not art recognized equivalents by any legal or chemical standard. The improper Markush group finds antecedent basis in case law, compare In re Swenson, 56 U.S.P.Q. 180; In re Ruzicka 66 U.S.P.Q. 226; In re Winnek 73 U.S.P.Q. 225; In re Harnisch 206 U.S.P.Q. 30,305 (CCPA 1980).**

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**Claims 7 and 15-17 as well as non-elected claimed subject matter appearing in claims 1-6 and 10-14 in-part stand withdrawn from further consideration, 37 CFR 1.142(b) as being drawn to non-elected inventions. Election was made without traverse in Paper No. 4 supra.**

**Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).**

**Claims 6, 8-10, 13 and 14 are rejected under 35 U.S.C. § 112(second par.) on the grounds of failing to define the invention properly. Specifically, the terms "double prodrug and salt thereof" render the claims indefinite and inoperative. It is not apparent what is meant by double pro drug, secondly, or salt thereof includes toxic salts such as arsenites, arsenates, hydrocyanates and the like which would render the claimed compounds inoperative for the intended medicinal purposes. In claim 13, line one the terms "preventing or" lack propriety.**

#### **REMARKS**

**The claimed compounds, their uses, compositions and the like would become allowable if the constructive suggestions of the undersigned Examiner are followed. Applicants Information Disclosure Statement in compliance with 37 C.F.R. 1.56 and 1.97 is noted with appreciation. None of the provided references are relevant to the elected invention.**

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*Alan L. Rotman*  
ALAN L. ROTMAN  
PRIMARY EXAMINER